

Application No. 10/614,114  
Amendment dated April 22, 2005  
Response to March 23, 2005 Office communication

#### **REMARKS/ARGUMENTS**

All claims have been amended to describe the lubricants of the invention as a material for lubricating a surface as set out in the last paragraph on page 68 of the written description. Applicant has amended the claims to include a material for lubricating a surface optionally with an organic lubricant, inorganic lubricant, or lubricant additive. The written description supports the organic lubricants at pages 6-14 and the paragraph bridging pages 25-26, whereas pages 15-18 support inorganic lubricants, additives at page 25, first full paragraph, lubricant additives specifically at pages 7-10, and mixtures at page 26, second full paragraph inter alia. In addition, original claims 6, 10, and 14 also support the amendments to the claims that describe the material for lubricating a surface.

#### **The Rejection under 35 U.S.C. § 112 First Paragraph and Traverse**

The examiner rejects claims 62-63 and 70-71 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the requirement that the written description convey to a person with ordinary skill in the art that the inventor was in possession of the invention comprising the coating applied to a substrate comprising a cable or a wire at the time he filed the application. The examiner argues that the application does not describe the substrate as a cable or a wire. Applicant traverses the rejection and requests further consideration and reexamination.

As to the coated wire, or coated cable, pages 6-19 of the written description describe the various lubricants used in combination with the superabsorbent polymer which include petroleum lubricants, synthetic lubricants, grease, solid lubricants and metal working lubricants. Importantly, page 20 of the written description states that applicant's lubricant composition

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comprises a superabsorbent polymer in combination with lubricants described in the written description which include those described at pages 6-19.

One of the lubricants described at pages 6-19 include the lubricants noted on page 12 which comprise cable lubricants. (written description, page 12, line 6 from the bottom). The application therefore supports the claims directed to the lubricant of the invention on a substrate comprising a cable.

Furthermore, one of the lubricants described at pages 6-19 of the written description includes a lubricant applied to a wire substrate (page 16, line 8 from the bottom, page 17, line 5 and page 47, line 8 from the bottom). The application therefore supports claims directed to the lubricant of the invention on a substrate where the substrate comprises a wire. The examples also specifically show the composition of the present invention on a wire substrate at page 51, first full paragraph, page 52, first and second paragraphs, page 53, line 3, and page 54, first and second full paragraphs by illustrating the use of a wire whip to manufacture the compositions.

The foregoing clearly shows the superabsorbent polymer/lubricant composition coated on a cable or a wire substrate does not comprise new matter. The applicant clearly had possession of this aspect of the invention at the time he filed the application.

#### **The Rejection under 35 U.S.C. § 103 (a) and Traverse**

The examiner rejects claims 57-63, 65-71, 73, 76, and 87-90 under 35 U.S.C. § 103 (a) as unpatentable over Freeman, United States Patent No.5,218,011 in view of Marciano-Agostinelli et al., United States Patent No. 5,049,593 (Marciano-Agostinelli). Applicant

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traverses the rejection and requests further consideration and reexamination.

Applicant distinguishes both Freeman and Marciano-Agostinelli because the references, either taken alone or in combination with one another, neither teach nor suggest applicant's essentially water-free composition, wherein the composition comprises a superabsorbent polymer that absorbs greater than 100 times its weight in water in combination with a material for lubricating a surface wherein the material for lubricating a surface comprises:

(1) a lubricating metal and alloy thereof, lubricating metal oxide, halide, nitride, carbonate and phosphate, or carbon lubricant; or

(2) a silicate ester, polyphenyl ether, phosphate, biphenyl, phenanthrene, or phthalocyanine;

the material for lubricating a surface optionally comprising an organic lubricant, inorganic lubricant, or a lubricant additive;

or mixtures thereof.

Additionally, Freeman and Marciano-Agostinelli, either taken alone or in combination with one another neither teach nor suggest the applicant's substrate coated with the presently claimed composition, or a method for protecting a substrate from the affects of water or water migration by employing the presently claimed composition. Granted both Freeman and Marciano-Agostinelli describe water absorbent polymers, but not in combination with the materials for lubricating a surface as in the claims of the present application.

#### **The Obviousness-Type Double patenting Rejection and Traverse**

The examiner rejects the application under the judicially created doctrine of

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obviousness-type of double patenting over the claims of United States Patent Application Serial No. 09/779,559. The United States Patent and Trademark Office has declared Application Serial No. 09/779,559 became abandoned after the examiner issued the March 23, 2005 Office communication in this application thereby making the double patenting rejection moot.

**Conclusions**

Applicant requests that the examiner withdraw the rejections in view of the foregoing amendments and remarks.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

By: /Robert J. Eichelburg, Reg. No. 23,057/

Dated: April 22, 2005

**CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)**

I hereby certify that this correspondence is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, Group Art Unit 1714, facsimile telephone number (703) 872-9306 on the date indicated below.

Dated: April 22, 2005

By: /Robert J. Eichelburg, Reg. No. 23,057/